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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,147	06/27/2003	Dante Monteverde	35041/400100	1146
27717 7590 12/31/2008 SEYFARTH SHAW LLP 131 S. DEARBORN ST., SUITE 2400 CHICAGO, IL 60603-5803				
EXAMINER CARLSON, JEFFREY D				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
12/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/604,147

Applicant(s)

MONTEVERDE, DANTE

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the paper(s) filed 10/14/2008.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. **Claims 1-5, 9, 10, 14-18 are rejected under 35 U.S.C. 102(a) as being anticipated by DeWolf et al (US 20020111172 A1).** DeWolf et al teaches location-based advertising provided to a user based on a profile that includes location history data. Paragraph 0087 states that the location profile can at least in part be built upon your history of Internet browsing and the geographic location of businesses/sites that you have visited on the Internet. Recognizing that the user has “visited numerous websites related to the “Outer Banks” (in North Carolina), the system can take this “external data” and estimate/determine the location of a user as well form as a basis for delivering advertising for merchants/services relevant to that determined geographic location. Delivering location-based advertising (Outer Banks advertising) according to a common geographic location associated with numerous Outer Banks web visits indicates that the Outer Banks is a popular geographic location for that user. The matching of a determined/estimated/predicted geographic location to advertisements is

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inherently accomplished by storage of merchant locations in a database which is used to match to the stored user profiles.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 6-8, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeWolf et al in view of Hooper et al (US 20030009762 A1).** Hooper et al also teaches providing customized advertising displays for users based upon their profiles. The profiles are created based upon various factors including demographics, residence location as well as Internet sites visited and the amount of time spent on each web site. It would have therefore been obvious to one of ordinary skill at the time of the invention to have also included time spent on visited web pages as a factor in determining user profiles which serve as the basis for the targeted ads of DeWolf et al. Official Notice is taken that it is well known to provide identification of Internet users by way of writing and reading cookies and matching to user account databases and would have been obvious to have done with the identified/tracked users of DeWolf et al.

6. **Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeWolf et al in view of Barnes, Jr. (US 20030065805 A1).** Barnes, Jr. also

teaches location-based advertising but also includes advertisers bidding on desired targeting criteria in order to have their ads included with search results for a user who has performed an Internet search [¶ 238]. It would have been obvious to one of ordinary skill at the time of the invention to have provided these features with that of DeWolf et al in order to enable ads on search pages.

Response to Arguments

7. Applicant argues that the instant invention need not use GPS which is a location method mentioned in DeWolf et al. However not only do applicant's claims fail to preclude auxiliary GPS usage, DeWolf et al clearly states that the relied upon "external data" of website visitations can be used in any combination with some or all of the other methods. Applicant's statement that "DeWolf et al actually discloses determining the location of a user based *exclusively* on data such as a GPS signal, cell phone, etc" is false.

8. Applicant argues that one of ordinary skill would be unable to determine a geographic location from a website. And yet, applicant describes one plausible method which is believed to be within the ability of one having ordinary skill - look for town names on a website. Further, it is well settled that search engines and advertising system rely on keywords and spidering of pages to form indexes of categorized webpages.

9. Applicant argues that DeWolf et al fails to match an advertisement to a location determined to be most popular. However this is taken to be present in DeWolf et al

where the Outer banks represents the users numerous visit, therefore providing a most popular location for that user.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc